

ATTORNEY'S DOCKET NUMBER: 2003946-0091 (IKKI/US)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Applicant: Daun, *et al.* Examiner: NYA  
 Serial No.: 10/500,840 Art Unit: NYA  
 Filed: July 7, 2004  
 Corresp. to Int. Appl. No.: PCT/US03/00366; Filed: January 7, 2003  
 For: DEAZAPURINES AND USES THEREOF

27 JAN 2005

Legal Staff  
International Division

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 Commissioner for Patents  
 Office of PCT Legal Administration  
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 Alexandria, VA 22313-1450

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January 18, 2005  
 Date

*Kathy Hart Gagnon*  
 Signature

Kathy Hart Gagnon

Typed or Printed Name of person signing certificate

Sir:

January 18, 2005

**RENEWED REQUEST UNDER 37 C.F.R. § 1.497(d)**

Applicant is filing this paper in response to the Decision on Request Under 37 C.F.R. § 1.497 (d) mailed November 15, 2004 (copy attached). That Decision set out a two-month period for reply. The deadline for filing a response is January 15, 2005, which falls on a Saturday. Accordingly, Applicant submits that this Reply, filed on the next business day January 18, 2005, is timely. Applicant hereby submits the following:

1. A written Consent of Assignee under 37 C.F.R. § 1.497 (d)(3) (2 pages);
2. Copies of 92bis letter requesting addition of Bruce DeCosta as co-inventor, filed in the International Phase on December 8, 2003 (including fax transmittal page, 92bis letter, PCT Power of Attorney executed by Bruce DeCosta, and fax transmission report) (5 pages), and Form PCT/IB/306 issued January 13, 2004 (1 page) attesting to the addition of Bruce DeCosta as co-inventor in the International Phase;
3. Statement under MPEP 201.3 regarding the incorrect spelling of the names of Inventors Motohiro Soejima and Yan (Janet) Zhao resulting from a transliteration or a typographical error (1 page); and copies of Declarations from Inventors Motohiro Soejima and Yan (Janet) Zhao attesting to the correct spelling of their names (2 page);

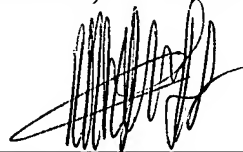
4. Declaration re-executed by Inventors Yimin Jiang, Boris M. Seletsky and Ye Yao in compliance with 37 C.F.R. § 1.52(c)(1) (7 pages).

Applicant submits that the requirements for the pending Request for Correction of Inventorship under 37 C.F.R. § 1.497(d) filed on October 14, 2004 to add co-inventor Mark Spyvee are now met. Favorable action is hereby requested.

It is not believed that fees are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that any additional fees are required for consideration of this paper, these fees are authorized to be charged to our Deposit Account No. 03-1721.

Respectfully Submitted,

CHOATE, HALL & STEWART



Nadège M. Lagneau, Ph.D.  
Reg. No. 51,908

Date: January 18, 2005

PATENT GROUP  
CHOATE, HALL & STEWART  
53 State Street  
Exchange Place  
Boston, MA 02109  
Phone: (617) 248-5000  
Fax: (617) 248-4000



15 NOV 2004  
UNITED STATES PATENT AND TRADEMARK OFFICE

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ALEXANDRIA, VA 22313-1450  
www.uspto.gov

Patent Department  
Choate Hall & Stewart  
Exchange Place  
53 State Street  
Boston, MA 02109

In re Application of  
DAUN, Jane et al.  
Application No.: 10/500,840  
PCT No.: PCT/US03/00366  
Int. Filing Date: 07 January 2003  
Priority Date: 07 January 2002  
Attorney Docket No.: 2003946-0091 (IKKI/US)  
For: DEAZAPURINES AND USES THEREOF

Correct Decl / Inventors  
Docketed  
Due 1-15-05 FINAL

DECISION

ON REQUEST UNDER

37 CFR 1.497(d)

This decision is in response to "Petition For Correction of Inventorship," filed in the United States Patent and Trademark Office on 18 October 2004.

#### BACKGROUND

On 07 January 2003, applicant filed international application PCT/US03/00366, which claimed a priority date of 07 January 2002. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 17 July 2003. The deadline for entry into the national stage in the United States was midnight on 07 July 2004.

On 07 July 2004, applicant filed a submission for entry into the national stage in the United States, accompanied by, *inter alia*, the U.S. Basic National Fee.

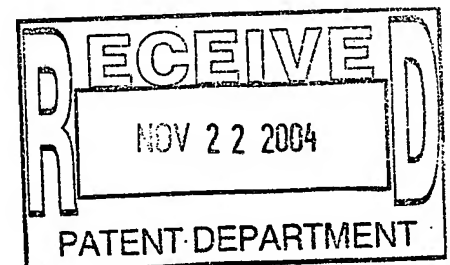
On 28 September 2004, the Office mailed Notification of Missing Requirements (Form PCT/DO/EO/905) requiring an oath or declaration in compliance with 37 CFR 1.497(a)-(b) and the fee for late filing of the oath or declaration.

On 18 October 2004, applicant filed a request under 37 CFR 1.497(d) and a declaration of the inventors.

#### DISCUSSION

Applicants file this request to add Mark Spyvee as inventor.

A request under 37 CFR 1.497(d) requires: (1) a statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part; (2) the processing fee set forth in §1.17(i); and (3) the written consent of the assignee, if an original named inventor has executed an assignment.



Items (1) and (2) have been met. Applicants have provided a statement from the person being added as an inventor, that any error in inventorship occurred without deceptive intention on his part. The processing fee set forth in §1.17(i) has been paid.

As to (3), applicants have indicated that the application was assigned, but have not furnished written consent from the assignee.

The declarations do not comply with 37 CFR 1.497(a)-(b). The declarations list "Bruce DeCosta" as an inventor, but he is not listed on the international application and no record of a 92bis change adding him as an inventor was located. If he is not an inventor in this application, an explanation of why the other inventors signed a declaration listing him as an inventor is required. If he was an inventor and should have been listed, applicants may submit a request under 37 CFR 1.497(d) to add him as an inventor.

Additionally, the declarations contained two name inconsistencies. First, the declaration lists "Motohiro Soejima" as an inventor, but the application lists "Motohiko Soejima." If this difference resulted from a transliteration or typographical error, a statement under MPEP 201.03 is required. Second, the application lists an inventor "Janet Y. Zhao", but the declaration lists "Yan (Janet) Zhao". An explanation of the disparity is required.

Finally, the declarations contain non-initialed, non-dated alterations in the form of redactions. 37 CFR 1.52(c)(1). The declarations submitted must be as executed by the inventors.

### CONCLUSION

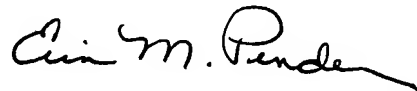
For the above reasons, applicants' petition under 37 CFR 1.497(d) is **DISMISSED** without prejudice.

A proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Request Under 37 CFR 1.497(d)".

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Leonard E. Smith  
PCT Legal Examiner  
PCT Legal Administration



Erin M. Pender  
Attorney Advisor  
PCT Legal Administration

Telephone: (571) 272-3292  
Facsimile: (571) 273-0459

ATTORNEY'S DOCKET NUMBER: 2003946-0091 (IKKI/US)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant:	Daun, <i>et al.</i>	Examiner:	NYA
Serial No.:	10/500,840	Art Unit:	NYA
Filed:	July 7, 2004		
Corresp. to Int.	Appl. No.: PCT/US03/00366; Filed: January 7, 2003		
For:	DEAZAPURINES AND USES THEREOF		

Mail Stop PCT  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

ATTN: Office of PCT Legal Administration

Sir:

**CONSENT OF ASSIGNEE UNDER 37 C.F.R. § 1.497(d)(3)**

Eisai Co., Ltd., the Assignee of entire interest in the subject matter of the above-referenced patent application, as evidenced by the Assignment sent for recordation on October 14, 2004, hereby consents to the addition of Mark SPYVEE as co-inventor to the above-referenced patent application.

More specifically, the Assignee agrees to the change of inventorship in the above-captioned patent application from Jane DAUN, Heather A. DAVIS, Bruce DeCOSTA, Fabian GUSOVSKY, Ieharu HISHINUMA, Yimin JIANG, Toshihiko KANEKO, Kouichi KIKUCHI, Seiichi KOBAYASHI, André LESCARBEAU, Xiang-Yi LI, Kenzo MURAMOTO, Norihito OHI, Marc PESANT, Boris M. SELETSKY, Motohiro SOEJIMA, Lynda TREMBLAY, Ye YAO, Hiromitsu YOKOHAMA, Yan (Janet) ZHAO, Wanjun ZHENG as co-inventors,

to

Jane DAUN, Heather A. DAVIS, Bruce DeCOSTA, Fabian GUSOVSKY, Ieharu HISHINUMA, Yimin JIANG, Toshihiko KANEKO, Kouichi KIKUCHI, Seiichi KOBAYASHI, André LESCARBEAU, Xiang-Yi LI, Kenzo MURAMOTO, Norihito OHI, Marc PESANT, Boris M. SELETSKY, Motohiro SOEJIMA, Mark SPYVEE, Lynda TREMBLAY, Ye YAO, Hiromitsu YOKOHAMA, Yan (Janet) ZHAO, Wanjun ZHENG as co-inventors.

Eisai Co., Ltd.  
6-10, Koishikawa 4-chome, Bunkyo-ku  
Tokyo, 112-8088  
Japan

Signature: Hiroshi Yoshino

Name: Hiroshi Yoshino

Title: Director of Intellectual Property

Department

On behalf of: Eisai Co., Ltd.

Date: December 28, 2004

## PATENT COOPERATION TREATY

BHTJ/MU/114

PCT

NOTIFICATION OF THE RECORDING  
OF A CHANGE(PCT Rule 92bis.1 and  
Administrative Instructions, Section 422)

From the INTERNATIONAL BUREAU

To:

LAGNEAU, Nadège, M.  
Choate, Hall & Stewart  
Exchange Place  
53 State Street  
Boston, MA 02109  
United States of America

Date of mailing (day/month/year)

13 January 2004 (13.01.2004)

Applicant's or agent's file reference

2003946-0016

## IMPORTANT NOTIFICATION

International application No.

PCT/US2003/000366

International filing date (day/month/year)

07 January 2003 (07.01.2003)

## 1. The following indications appeared on record concerning:

☐

the applicant

☐

the inventor

☐

the agent

☐

the common representative

Name and Address

State of Nationality

State of Residence

Telephone No.

Facsimile No.

Teleprinter No.

## 2. The International Bureau hereby notifies the applicant that the following change has been recorded concerning:

☐

the person

☐

the name

☐

the address

☐

the nationality

☐

the residence

Name and Address

State of Nationality

State of Residence

DE COSTA, Bruce  
99 Cluff Crossing Road, Apt. C9  
Salem, NH 03079  
United States of America

GB

US

Telephone No.

Facsimile No.

Teleprinter No.

## 3. Further observations, if necessary:

The person identified in Box 2 should be added to the record as applicant/inventor for the  
United States of America only

## 4. A copy of this notification has been sent to:

☒

the receiving Office

☐

the designated Offices concerned

☐

the International Searching Authority

☒

the elected Offices concerned

☒

the International Preliminary Examining Authority

☐

other:

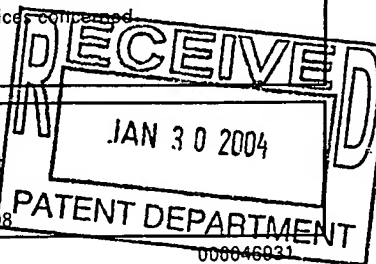
The International Bureau of WIPO  
34, chemin des Colombettes  
1211 Geneva 20, Switzerland

Authorized officer

S. Diot

Facsimile No. (41-22) 338.87.40

Telephone No. (41-22) 338 9668



**CHOATE, HALL & STEWART**

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EXCHANGE PLACE

53 STATE STREET

BOSTON, MASSACHUSETTS 02109-2804

TELEPHONE (617) 248-5000 • FAX (617) 248-4000

WWW.CHOATE.COM

**TELECOPY TRANSMITTAL SHEET**

**CONFIDENTIAL**

Number of pages being sent 4 (including this page)

**DATE:** 8 December 2003

	Recipient	Company	Fax No.	Phone No.
1.	International Bureau of WIPO		011-41-22-740 14 35	011-41 22 338 93 61
2.	Mail Stop PCT (RO/US)	Commissioner for Patents		

**FROM:** Nancy J. Hough, Foreign Filing Specialist

**DIRECT DIAL:** (617) 248-5188

**REMARKS:**

Applicant : EISAI CO. LTD.  
Serial No.: PCT/US03/00366  
Filed : 7 January 2003  
For : NOVEL DEAZAPURINES AND USES THEREOF  
Attorney Docket Number: 2003946-0016

Please find attached *Request for Change Under Rule 92bis* in the above-captioned application together with power of attorney for Bruce DE COSTA.

**TIME SENT:** \_\_\_\_\_ **OPERATOR:** \_\_\_\_\_ **CLIENT NO.** 2003946-0016

Return by: Inter-office Mail NHough/34 Hold for pick-up \_\_\_\_\_

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IN THE INTERNATIONAL BUREAU OF WIPO

Applicant : EISAI CO. LTD.  
Serial No.: PCT/US03/00366  
Filed : 7 January 2003  
For : NOVEL DEAZAPURINES AND USES THEREOF  
Attorney Docket Number: 2003946-0016

**REQUEST UNDER RULE 92bis**

Gentlemen:

It is respectfully requested that the application be amended to reflect the addition of the following inventor/applicant:

DE COSTA, Bruce  
99 Cluff Crossing Road, Apt. C9  
Salem, New Hampshire 03079  
UNITED STATES OF AMERICA  
Citizenship: UNITED KINGDOM

A copy of Bruce DE COSTA's power of attorney is attached.

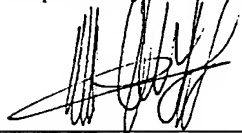
It is further respectfully requested that the application be amended to reflect the following changes in the address of the Applicant, EISAI CO., LTD. wherein the words corrected are shown in bold letters:

EISAI CO., LTD.  
6-10 Koishikawa 4 Chome  
Bunkyo-ku,  
Tokyo, JAPAN 112-8088

Applicant requests that these changes be communicated to the Receiving Office (US/RO). It is further requested that the International Bureau notify all interested Offices and PCT Authorities of the changes.

Please acknowledge receipt by signing and returning a copy of this letter by fax to 617-248-4000 (Attn. N. M. Lagneau, Ph.D.).

Respectfully submitted,



---

Nadège M. Lagneau  
Agent for Applicants  
Reg. No. 51,908

CHOATE, HALL & STEWART  
53 State Street  
Boston, Massachusetts 02109  
UNITED STATES OF AMERICA  
Tel: (617) 248-5000  
Fax: (617) 248-4000

CC: Mail Stop PCT (RO/US)  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22303-1450

Date: 8 December 2003

Client No. 2003946

PATENT COOPERATION TREATY

General Appointment of Agent or Common Representative

Each undersigned applicant hereby appoints:

Sam Pasternack  
Donald W. Muirhead  
Brenda Herschbach Jarrell  
Anne E. Saturnelli  
Kevin M. Tormey  
Elizabeth E. Nugent  
Theresa A. Devlin  
Valarie B. Rosen  
Charles Hunter Baker  
Monica R. Gerber  
Elijah Cocks  
Charles Lyon  
Nadège M. Lagneau  
Stacy Blasberg  
Choate, Hall & Stewart  
Exchange Place  
53 State Street  
Boston, Massachusetts 02109  
United States of America

X as agent

\_\_\_\_\_ as a common representative

to act on his/her behalf before the competent International Authorities in connection with any and all international applications filed by him/her and of which he/she is an applicant and to make and receive payments on his/her behalf.

\_\_\_\_\_  
Place

Date: 14 November 2003

Name: \_\_\_\_\_

Bruce De Costa  
Bruce De COSTA

\* \* \* COMMUNICATION RESULT REPORT ( DEC. 8. 2003 2:15PM ) \* \* \*

FAX HEADER: CHOATE HALL &amp; STEWART 6172484000

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E-3) NO ANSWERE-2) BUSY  
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Recipient	Company	Fax No.	Phone No.
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2. Mail Stop PCT (RO/US)	Commissioner for Patents		

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DIRECT DIAL: (617) 248-5188

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Return by: Inter-office Mail NHough/34

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Office of PCT Legal Administration  
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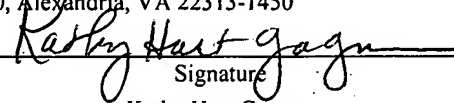
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Sir:

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January 18, 2005  
Date

  
Signature  
Kathy Hart Gagnon

Typed or Printed Name of person signing certificate

January 18, 2005

**STATEMENT UNDER MPEP 201.03**

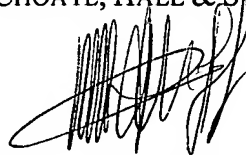
Applicant respectfully submits that the listing of Inventor Soejima's name on PCT Application No.: PCT/US03/00366 as "Motohiko Soejima" resulted from a typographical error. The correct spelling is Motohiro Soejima. A Declaration from Inventor Motohiro Soejima is provided in accompanying papers.

In addition, the listing of Inventor Zhao's name on PCT Application No.: PCT/US03/00366 as "Janet Y. Zhao" resulted from a transliteration error. "Janet" is Inventor Yan Zhao's adopted English given name. However, the inventor uses her Chinese given name, Yan, as her first name. A Declaration from Inventor Yan (Janet) Zhao is provided in accompanying papers.

It is not believed that fees are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that any additional fees are required for consideration of this paper, these fees are authorized to be charged to our Deposit Account No. 03-1721.

Respectfully Submitted,

CHOATE, HALL & STEWART



---

Nadège M. Lagneau, Ph.D.  
Reg. No. 51,908

Date: January 18, 2005

PATENT GROUP  
CHOATE, HALL & STEWART  
53 State Street  
Exchange Place  
Boston, MA 02109  
Phone: (617) 248-5000  
Fax: (617) 248-4000

# INVENTOR'S DECLARATION

JAPAN

I, a named inventor of PCT Application No.: PCT/US03/00366, do hereby certify and attest that my correct name is:

**Motohiro SOEJIMA**

but not Motohiko SOEJIMA, as indicated on PCT Publication No.: WO 03/057696.

IN WITNESS WHEREOF, I hereto set my hand and seal at Tsukubashi,  
Japan, this 2 day of September, 2004. (City)

Motohiro Soejima  
**Motohiro SOEJIMA**

INVENTOR'S DECLARATION

COUNTY OF: Essex

STATE OF: Massachusetts

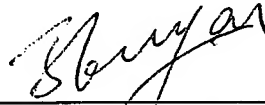
UNITED STATES OF AMERICA

I, a named inventor of PCT Application No.: PCT/US03/00366, do hereby certify and attest that my correct name is:

**ZHAO, Yan (Janet)**

but not **Zhao, Janet, Y.**, as indicated on PCT Publication No.: WO 03/057696.

IN WITNESS WHEREOF, I hereto set my hand and seal at \_\_\_\_\_,  
United States of America, this 19 day of August, 2004.



\_\_\_\_\_  
Yan (Janet) ZHAO